

### **REMARKS/ARGUMENTS**

The final Office Action dated December 16, 2003 has been received and its contents carefully considered. Claims 1-5, 7-12, 14-16, 19 and 20 are pending. Claims 1-5, 7-12, 14-16, 19 and 20 have been rejected. Claims 1, 7-9, 14-16, and 20 have been amended. Claims 6, 13, and 17-18 have been cancelled. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

### **SPECIFICATION**

The specification has been amended to denote an outer end face previously shown in FIG. 3. Now new matter has been added.

### **DRAWINGS**

FIG. 3 has been amended to specifically denote the outer end face as item 21.

### **CLAIM REJECTIONS – 35 U.S.C. § 102(b)**

Claims 1-4, 7-8, 16 and 19-20 were rejected under 35 U.S.C. §102(b) as being anticipated by *Sorenson*. Without conceding propriety of the rejection independent claims 1 and 16 have been amended. It is respectfully submitted that *Sorenson* does not teach, *inter alia*, an extensible handle comprising “a hollow second elongated member having a first end and a second end wherein the first end has an outer end face...wherein, in order to prevent movement in an actual direction, the first end of the second elongated member is configured to be retained along a surface of the outer end face by the restricting device,” as recited in claim 1 and similarly in claim 16.

*Sorenson* discloses a handle assembly for adjustably positioning a paint roller including an inner telescoping tube element 26. A lock assembly 80 may be configured thereto in order to facilitate retention of the telescoping tube within an outer tube 32 including a forward end portion 54. The Examiner equivocates the telescoping tube element 26 as the first elongated member of the present invention. *Sorenson* teaches away from the invention as claimed because the lock assembly 80 couple to the telescoping tube 26 is retained against an inner surface of the outer tube 32, whereas the first end of the second elongated member of the present invention is configured to be retained along the surface of the outer end face by its restricting device as recited in claim 1 and similarly in claim 16. Thus, the particulars of *Sorenson*'s invention teach a structurally different handle assembly than the extensible handle of the present invention.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P., *Sorenson* cannot be said to anticipate the invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 2-4 and 7-8 ultimately depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 19-20 ultimately depend from independent claim 16 and are patentable over the cited prior art for at least the same reasons as is claim 16.

### **CLAIM REJECTIONS – 35 U.S.C. § 103(a)**

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Sorenson* as applied to claims 1-4, 7-8, 16 and 19-20 in view of *Messier*. Claim 5 depends from independent claim 1 and is patentable over the cited prior art for at the same reasons as is claim 1.

Specifically, *Sorenson* does not teach, *inter alia*, an extensible handle comprising “a hollow second elongated member having a first end and a second end where the first end has an outer end face...wherein, in order to prohibit movement in an axial direction, the first end of the second elongated member is configured to be retained along a surface of the outer end face by the restricting device” as recited in claim 1. *Messier* does not cure the deficiencies of *Sorenson* because it, too, lacks a teaching of the aforementioned features as claimed.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 f.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Since each and every claim limitation is not taught by the cited prior art, *Sorenson*, alone, or in combination with *Messier*, cannot be said to teach the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 9-12 and 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Tallman* in view of *Sorenson*. Without conceding propriety of the rejection, independent claim 9 has been amended. It is respectfully submitted that *Tallman* does not teach, *inter alia*, an apparatus from moving an item comprising “a second elongated member having a first end and second end wherein the first end has an outer end face...wherein, in order to prohibit movement in an axial direction, the first end of the second elongated member is configured to be retained along a surface of the outer end face by the restricting device,” as recited in claim 9. *Sorenson* does not cure the deficiencies of *Tallman* because it, too, lacks a teaching of the aforementioned

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features as claimed. Since each and every claim limitation is not taught by the cited prior art, *Tallman*, alone or in view of *Sorenson*, cannot teach the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

### CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

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# Annotated Mark-Up



FIG. 3

